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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR        | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------------|---------------------|------------------|
| 10/680,381  | 10/08/2003  | Taizo Shirai                | 241909US6           | 2411             |
| 22850 7590 10/14/2010<br>OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                             |                     |                  |
| EXAMINER<br>REAGAN, JAMES A   |             |                             |                     |                  |
| ART UNIT<br>3621  |             | PAPER NUMBER                |                     |                  |
| NOTIFICATION DATE<br>10/14/2010   |             | DELIVERY MODE<br>ELECTRONIC |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/680,381

**Applicant(s)**

SHIRAI ET AL.

**Examiner**

JAMES A. REAGAN

**Art Unit**

3621

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-24 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-24 and 34-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the response filed on **08/23/2010**.
2. Claims 1-4, 6-24, and 34-37 are currently pending and have been examined.

## **RESPONSE TO ARGUMENTS**

3. Applicant's arguments received **08/23/2010** have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

Applicant asserts, "...Claim 1 requires a control unit that stops playing or using streaming contents when an authentication processing that is conducted when the information processing device is receiving the streaming contents fails. Both Stefik and Breiter are silent as to at least those features of Claim 1." The Examiner respectfully disagrees and points to **BREITER** paragraph 0005 wherein **BREITER** discloses, "The access checking unit checks whether a user has a privilege to access the protected information entity based on the protection specification and the access control manager, and checks whether the requested access meets conditions determined based on the protection specification and enforced by the enhanced access control manager. An example of the enhanced access control manager is a terms and conditions enforcement manager for enforcing the terms and conditions of an agreement relating to permitted uses of the protected information entity." In addition, see at least paragraphs 0040+.

#### **Previous Claim Rejections - 35 USC § 112**

4. Claims 1, 8, 10, 12, 19, and 36 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner thanks the Applicant for the clarifications and hereby withdraws the rejections under 35 U.S.C. 112, second paragraph.

#### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3621

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
8. Claims 1-4, 6-24, and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik (USPGP 2005/0086172 A1), hereinafter **STEFIK**, in view of Breiter et al. (USPGP 2003/0079133 A1), hereinafter **BREITER**.

**Claim 1:**

**STEFIK** as shown below discloses the following limitations:

- *a communication unit for executing communication processing with a license storage device storing rights information serving as usage rights information of contents associated with a user of the information processing device, and communication processing with a contents distribution server; (see at least Figures 1-4b as well as associated and related text)*

Art Unit: 3621

- *an encryption processing unit for executing encryption processing including authentication processing in said communication processing; (see at least paragraph 0056)*
- *a control unit for executing processing control for inputting rights information corresponding to contents from said license storage device, via said communication unit, transmitting said input rights information, which indicates rights to receive streaming contents, to said contents distribution server, and receiving streaming contents set corresponding to said transmission rights information from said contents distribution server and playing or using said streaming contents, the control unit stopping the playing or the using of said streaming contents when a subsequent authentication processing, conducted when the information processing device is receiving said streaming contents, fails (see at least Figures 1-4b as well as associated and related text; Figure 15 as well as associated and related text; Figures 16-19 as well as associated and related text)*

**STEFIK** discloses downloading of digital files and data but does not specifically disclose streaming data. In addition, **STEFIK** discloses content repositories, digital rights, and licenses, but does not specifically disclose a license server per se. **BREITER**, however, in at least paragraph 0012 discloses licenses provided through servers, and in paragraph 0039 discloses streaming data through the Internet. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine/modify the DRM method of **STEFIK** with the online licensing and streaming technique of **BREITER** because this enables, "...the prevention of uncontrollable downloads through the network within P2P (point to point) scenarios, such as Napster, and also unauthorized duplication of content on media, such as CD or DVD." (**BREITER**: paragraph 0004)

Art Unit: 3621

**Claim 2:**

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses *said encryption processing unit has a configuration for executing verification processing for a tampering verification value attached to contents-corresponding rights information input from said license storage device, said encryption processing unit executing authentication processing at least once while the information processing device is receiving said streaming contents.* See at least paragraph 0363.

**Claim 3:**

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses:

- *said encryption processing unit executes mutual authentication with said license storage device;*
- *wherein said control unit has a configuration for executing input processing of contents-corresponding rights information input from said license storage device via said communication unit, with the establishment of said mutual verification as a precondition thereof.*

See at least paragraphs 0362 and Figures 1-4b as well as associated and related text.

**Claim 4:**

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses:

- *said encryption processing unit has a configuration for executing mutual authentication and key-sharing processing with said license storage device, and for executing verification processing for a tampering verification value attached to contents-corresponding rights information input from said license storage device via said communication unit, applying a key generated in said key-sharing processing.*

See at least paragraphs 0356, 0362, and 0363.

**Claim 6:**

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses:

- *said encryption processing unit has a configuration for executing mutual authentication and key-sharing processing with said contents distribution server, and for executing verification processing for a tampering verification value attached to a contents file from said contents distribution server via said communication unit, applying a key generated in said key-sharing processing.*

See at least paragraphs 0356, 0362, and 0363.



**Claim 7:**

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses:

- *said encryption processing unit has a configuration for executing mutual authentication and key-sharing processing with said contents distribution server, and for executing decryption of an encrypted contents encryption processing key attached to a contents file from said contents distribution server via said communication unit, applying a key generated in said key-sharing processing.*

See at least paragraphs 0356, 0362, and 0363.

**Claim 8:**

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses:

- *header information of a contents file received from said contents distribution server contains RHD check mode information setting whether or not to take connection with said license storage device at the time of playing contents as a precondition thereof;*
- *wherein said encryption processing unit executes mutual authentication processing with said license storage device for contents playing processing wherein said RHD check mode information takes connection with said license storage device at the time of playing contents as a precondition thereof;*
- *wherein said control unit performs contents playing processing with establishment of said authentication as a precondition thereof.*

See at least paragraphs 0108, 0450, 0356, 0362, and 0363; Figure 15 as well as associated and related text.

Art Unit: 3621

**Claim 9:**

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses:

- *header information of a contents file received from said contents distribution server contains output control information of contents;*
- *wherein said control unit executes output control of contents following said output control information.*

See at least paragraphs 0108, 0450, 0356, 0362, and 0363; Figure 15 as well as associated and related text.

**Claim 10:**

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses:

- *said rights information contains contents distribution server information or index server information of a server capable of providing streaming contents corresponding to said rights information;*
- *wherein said control unit is of a configuration for executing processing for deciding a connection destination based on said contents distribution server information or said index server information.*

See at least paragraphs 0108, 0450, 0356, 0362, and 0363; Figure 15 as well as associated and related text.

Art Unit: 3621

**Claim 11:**

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. **STEFIK** further discloses *control unit is of a configuration for executing processing for transmitting, to a contents distribution server providing contents, specs information including data format information of data formats playable at the information processing device serving as a contents using device, along with said rights information.* See at least paragraphs 0108, 0450, 0356, 0362, and 0363; Figure 15 as well as associated and related text.

**Claims 12-24 and 34-37:**

The combination of **STEFIK/BREITER** discloses the limitations as shown in the rejections above. The Examiner finds that remaining claims 12-24 and 34-37 are not patentably distinct from claims 1-4 and 6-11 and therefore, for the sake of clarity, has grouped the rejections of claims 1-4, 6-24, and 34-37 accordingly using the same references and citations as above.

**Conclusion**

9. Applicant's amendment filed on **08/23/2010** necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
  
10. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3621

11. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** ([james.reagan@uspto.gov](mailto:james.reagan@uspto.gov)) whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **ANDREW J. FISCHER** can be reached at **571.272.6779**.
12. Should Applicant desire in the future to receive formal or informal email communications from the Examiner (e.g. acknowledgments, references, courtesy copies of documents, etc.), the electronic file must contain written authorization to conduct email communications. See MPEP §502.03 III. For Applicant's benefit, exemplary language for written authorization is in MPEP §502.03 III. ¶4. The exemplary language is:

***Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file.***

13. In the situation where Applicant desires to receive email communications from the Examiner, the Examiner suggests placing the above exemplary language in Applicant's next correspondence.

Art Unit: 3621

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

15. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to **571-273-8300**.

16. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

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